REMARKS

Pending claims

Claims 1-11, 13, 15-17, 19, 22 , 26, and 27 are the claims for which Applicants have paid. Claims 12, 14, 18, 20, 21, 23-25, and 28-204 were intended to be cancelled previously as stated in Item 13 of the Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing under 35 U.S.C. 371). The Examiner's attention is directed to the enclosed copy of the Transmittal Letter mailed December 11, 2001, which included a preliminary amendment that canceled claims 12, 14, 18, 20, 21, 23, 24, 25, and 28-204. Applicants again request the cancellation of these claims. Applicants submit that these claims were included in the application as filed in the interest of providing notice to the public of certain specific subject matter intended to be claimed, and were intended to be canceled at the time of filing this application in the interest of reducing filing costs. Applicants expressly state that these claims are **not** being canceled for reasons related to patentability, and are in fact fully supported by the specification as filed. Applicants expressly reserve the right to reinstate these claims or to add other claims during prosecution of this application or a continuation or divisional of this application. Applicants expressly do not disclaim the subject matter of any invention disclosed herein which is not set forth in the instantly filed claims.

Restriction Requirement

Applicants hereby elect, with traverse, to prosecute Group II, which corresponds to newly added claims 210-218 and 224-231 drawn to polynucleotides, variants thereof, a recombinant polynucleotide, a cell transformed with a recombinant polynucleotide, a microarray, an array, a method of using a polynucleotide to produce a polypeptide, and a method of using a microarray to produce transcripts. Newly added claims 210-218 and 224-231 replace original claims 3-7, 9, 11, 12, 96-104, and 155-204, and are drawn to substantially the same invention, but are of a different scope.

Applicants also respectfully submit that there is minimal additional burden on the Examiner to examine newly added claims 219-221 (Group V), 222 (Group XI), and 223 (Group XII), which are drawn to methods of using the elected polynucleotides.

The Examiner is reminded that claims 219-223 should be rejoined per the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and

Process Claims in light of *In re Ochiai, In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the same scope of products. Applicants request that claims 219-223 be rejoined and examined upon allowance of the claims drawn to the polynucleotides of Group II.

In addition, in response to the restriction requirement to elect one polynucleotide, Applicants provisionally elect SEQ ID NO:12. Applicants reserve the right to prosecute non-elected subject matter in subsequent divisional applications.

Applicants respectfully submit that claims 205-209, drawn to polypeptides encoded by the polynucleotides of Group II should also be examined according to the unity of invention standard.

The unity of invention standard ***must*** be applied in national stage applications

Section 1850 of the Manual of Patent Examining Procedure (original 8th edition, published August, 2001) (hereinafter "MPEP") provides:

> ... [W]hen the Office considers international applications ... during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111....
>
> In applying PCT Rule 13.2 to ... national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2....

Id at page 1800-60 to -61.

MPEP section 1893.03(d) reiterates the Examiner's obligation to apply the Unity of Invention standard PCT Rule 13.2 instead of U.S. restriction/election of species practice:

> Examiners are reminded that unity of invention (not restriction) practice is applicable ... in national stage (filed under 35 U.S.C. 371) applications.

Id at page 1800-149, column 1.

Specific provisions of the Administrative Regulations Under the PCT and the corresponding provisions of the MPEP strongly support a finding of unity of invention among the claims drawn to polypeptides and the claims drawn to polynucleotides in the present case

Unity of Invention is accepted as between claims to polypeptide sequences and claims to the polylnucleotide sequences which encode them

Example 17, Part 2 of Annex B to the Administrative Instructions Under the PCT provides that unity of invention is accepted as between claims to polypeptide sequences and claims to polynucleotide sequences encoding those polypeptides. Those Examples are cited in MPEP section 1893.03(d) at page 1800-149, column 2 ("[n]ote also examples 1-17 of Annex B Part 2 of the PCT Administrative Instructions...")

Thus, in the present case, unity of invention exists at least for claims drawn to the polypeptide sequence of SEQ ID NO:12 (*i.e.,* claims 205-207) and claims drawn to the polynucleotide sequence of SEQ ID NO:64 which encodes SEQ ID NO:12 (*i.e.,* claims 210-214, 217, and 218).

Therefore, Applicants request that the Examiner withdraw the Restriction Requirement at least with respect to claims 205-207, and examine those claims together with the elected polynucleotide claims of Group II.

Please charge Deposit Account No. **09-0108** in the amount of **$126.00** as set forth in the enclosed fee transmittal letter. If the USPTO determines that an additional fee is necessary, please charge any required fee to Deposit Account No. **09-0108.**

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Claims 1-204 have been canceled.

Claims 205-231 have been added.